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09/773,297	01/31/2001	Thomas J. Walsh	LUT 2 0053	6399

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EXAMINER

RUTTEN, JAMES D

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/773,297

Applicant(s)

WALSH, THOMAS J.

Examiner

J. Derek Rutten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Acknowledgement is made of Applicant's amendment dated July 27, 2004, responding to the January 21, 2004 Office Action provided in the rejection of claims 1-21, wherein claims 1, 2, 6, 8, 9, 13, 15, 16, and 21 have been amended, no claims have been canceled, and no new claims have been added. Claims 1-21 remain pending in the application and have been fully considered by the examiner.

2. Applicant has primarily argued that the claims are not anticipated by the McFarland reference because it does not disclose "findings" and/or "observations" as used in the claims. This argument is not persuasive, as McFarland also covered these amended claim limitations and will be addressed under the *Prior Art's Arguments – Rejections* section below.

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Prior Art's Arguments – Rejections

4. Applicant argues at the bottom of page 8 of the filed response that “there are no details provided as to how quality control audits are actually carried out.” Applicant is directed to review Figures 1 and 2 and the associated text from McFarland column 9 lines 5-45. Also, McFarland expressly discloses using “Lotus Notes” to implement the invention. Further details of implementation can be found throughout McFarland.

5. Applicant essentially argues at the top of page 9 that McFarland’s “findings” are not the same as the use of “finding” as defined in the claims. The examiner disagrees. Applicant defines a “finding” to be “a deficiency in the audited activity such that an action is mandated to be taken by the organization to correct the deficiency.” McFarland discloses findings in the context of “non-conformities” or “noncompliance” according to the similar definition provided by the Applicant and in accordance with ISO 9000 standards. Evidence is found at column 3 lines 4-7:

Also, as required by Section 4.14, **corrective or preventative action must be taken for meeting quality objectives**. Once a quality system is running, the company can call a certification body for an external audit.

Also column 3 lines 12-16:

Following the documentation review, the company must **take into account non-conformities and put in place corrective actions**, so that the documentation complies with the requirements of the certification body.

Also column 24 lines 62-66:

Corrective Action Plans are generated whenever there is a noncompliance to IS 9000, or any other standard, observed during an internal or external audit and which is also supported by objective evidence.

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Thus, McFarland's findings are not simply "results" as alleged by the Applicant, but are a vehicle for implementation of corrective action (mandated action to correct deficiencies) as described in the claim.

6. Applicant essentially argues in paragraph 2 on page 9 that McFarland does not teach observations representing a non-mandatory recommendation regarding the audited activity.

However, review of McFarland column 28 lines 24-27 reveals such disclosure:

The audit management module 20 also supports **items which do not fall into non-compliance status**, but may in the future. **These are identified as observations** and ties them to the audit in which they were found.

Thus, McFarland clearly discloses such observations as described in Applicant's response, and further clearly distinguishes between various results of an audit.

7. Applicant argues at the bottom of page 9 that the claimed elements are not arranged in McFarland as required. In support of this argument, Applicant alleges that "the Office Action takes unrelated passages out of context from various diverse parts of the McFarland reference and recombines them in an attempt to read on the claimed invention", and that "unrelated text is cited from columns 10, 16, 24, 3, and 8". However, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

8. In response to applicant's argument on page 10 that there is no suggestion to combine McFarland with Ivanov, the examiner recognizes that obviousness can only be established by

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combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, suggestion to combine comes from the cited passage in the reference itself, e.g. Ivanov column 6 lines 6-9 suggests a method for handling cases when reviewers do not review a document within the allowed time frame. Since McFarland sends documents to different users, McFarland would be interested in ensuring that those documents are looked at, otherwise that document may not be handled in a timely manner. Thus, Ivanov provides a suggestion to combine through a description of potential problems with McFarland's workflow.

Oath/Declaration

9. The objection to the declaration found in the Office action dated January 21, 2004 will be held in abeyance at the request of the Applicant on page 8 of the response. However, a new declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date will be required once allowable subject matter is identified. See MPEP §§ 602.01 and 602.02.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

11. Claims 1-3, 7-10, and 14-18 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent 6,154,753 to McFarland (hereinafter referred to as “McFarland”).

As per claim 1, McFarland discloses a method (column 3 lines 49-50:

“Accordingly, the present invention is directed to a computer implemented system and **method...**”), the method comprising:

documenting, within a database included in a network accessible by the organization and an auditing entity, an activity to be audited; auditing the activity; determining if the audited activity produced a finding, said find representing a deficiency in the audited activity such that an action is mandated to be taken by the organization to correct the deficiency; if the audited activity produced the finding, documenting the finding within the database - See column 10 lines 34-42:

Referring to FIG. 7, the audit management module 20 includes a single **database** that **plans**, **executes**, and **records** internal process audits, configuration management audits, and **external 3rd party audits**. As shown at block 150, the audit management module generates an audit schedule, supports recording of internal and **external auditors findings**, prescribes corresponding pre-formatted forms, retains records in a single bundle, supports corrective action plans, and supports verification of corrective action effectiveness.”

This passage describes an auditing entity which uses a database to plan an audit, and records a determination of findings produced by performing the audit.

Also column 24 lines 62-66:

Corrective Action Plans are generated whenever there is a **noncompliance** to IS 9000, or any other standard, **observed during an internal or external audit** and which is also supported by objective evidence.

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This passage implicitly defines a finding as an observed noncompliance or deficiency that results in a mandated corrective action for correcting the reported deficiency.

automatically transmitting, via the network, a notification of the finding from the auditing entity to the organization. - See column 16 lines 2-5:

Automatic notification of task and action item assignment is available assuming that appropriate E-Mail is also activated and the person assigned the task has E- Mail facilities.

As per claim 2, McFarland discloses:

determining if the audited activity produced an observation, said observation representing a non-mandatory recommendation regarding the audited activity (See column 28 lines 24-27); if the audited activity produced the observation, documenting the observation within the database (column 24 lines 6-9); and automatically transmitting, via the network, a notification of the observation from the auditing entity to the organization (column 16 lines 2-5 as cited above).

As per claim 3, McFarland discloses *resolving the finding* (column 24 lines 9-14: **implementation** of corrective action plans.).

As per claim 7, McFarland discloses *transmitting a report summarizing the finding, via the network, to a predefined addressee* (column 16 lines 2-5; also column 25 line 44 – column 26 line 15).

As per claim 8, McFarland discloses a *system* (column 3 lines 49-50:

“Accordingly, the present invention is directed to a computer implemented system and method...”);

a network; a client computing device communicating with the network; a server

computing device communicating with the network (column 8 lines 25-30: “In the

preferred implementation of the invention, a well known software platform was used,

entitled **Lotus Notes**, which is a registered trademark of Lotus Development Corporation.

However, any platform may be used which has code permitting the creation of the

system, apparatus, and method of the present invention.” Lotus Notes inherently uses a

client computing device communicating with a server computing device. Without a

server, the client would not be able to fully function.); *and*

a database communicating with the network, the activity to be audited being documented

within the database, an auditing entity auditing the activity, if the audited activity

produces a finding, the finding being documented within the database (column 9 lines 1-

3: “In the preferred implementation, shared databases are sometimes used, which are

contained in a server to be accessible by designated members of an organization.” In this

passage, the database is contained in a server which is a network device; also column 10

lines 34-42: “Referring to FIG. 7, the audit management module 20 includes a single

database that plans, executes, and **records** internal process audits, configuration

management audits, and **external 3rd party audits**. As shown at block 150, the audit

management module generates an audit schedule, supports recording of internal and

external auditors findings, prescribes corresponding pre-formatted forms, retains

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records in a single bundle, supports corrective action plans, and supports verification of corrective action effectiveness.” This passage describes an auditing entity which uses a database to plan an audit, and records a determination of findings produced by performing the audit.), *and* a notification of the finding being transmitted, via the network, from the auditing entity to the organization (column 16 lines 2-5: “Automatic **notification** of task and **action item** assignment is available assuming that appropriate E-Mail is also activated and the person assigned the task has E- Mail facilities.” Email is inherently transmitted via a network since it is a client/server application.).

All further limitations have been addressed in the above rejection of claim 1.

As per claim 9, the rejection of claim 8 is incorporated. All further limitations have been addressed in the rejection of claim 2 above.

As per claim 10, the rejection of claim 8 is incorporated. McFarland further discloses resolution of a finding using computers communicating across a network (column 24 lines 9-14: **implementation** of corrective action plans; also column 15 lines 56-57).

As per claim 14, the rejection of claim 8 is incorporated. All further limitations have been addressed in the rejection of claim 7 above.

As per claim 15, McFarland discloses *A method* (column 3 lines 49-50:

“Accordingly, the present invention is directed to a computer implemented system and method...”),

the method comprising:

identifying an activity to be audited; auditing the activity; and if the audited activity

produces a finding, documenting the finding (column 10 lines 34-37: “Referring to FIG.

7, the audit management module 20 includes a single database that **plans**, executes, and

records internal process audits, configuration management audits, and **external 3rd**

party audits.” This passage describes an auditing entity which uses a database to plan an audit, and records findings produced by performing the audit.).

All further limitations have been addressed in the above rejection of claim 1.

As per claims 16 and 18, the rejection of claim 15 is incorporated. All further limitations have been addressed in the rejection of claims 2 and 3, respectively, above.

As per claim 17, the rejection of claim 16 is incorporated. All further limitations have been addressed in the rejections of claims 1 and 2 above.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 4-6, 11-13, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over McFarland as applied to claims 3, 10, and 18, respectively above, and further in view of U.S. Patent 5,706,452 to Ivanov (hereinafter referred to as "Ivanov").

As per claim 4, McFarland discloses *developing, within the organization, a proposed response for resolving the finding* (column 24 lines 9-14: **development of corrective action plans.**);

McFarland does not expressly disclose *transmitting, via the network, the proposed response to the auditing entity.*

However, in an analogous environment, Ivanov teaches using a workflow manager to send network notification of document status (column 5 lines 25-30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Ivanov's network notification system to distribute McFarland's proposed response. One of ordinary skill would have been motivated to use an automatic and efficient notification system.

As per claim 5, the rejection of claim 4 is incorporated, and further, McFarland discloses *determining if the proposed response is acceptable to the auditing entity* (column 13 lines 23-26);

if the proposed response is acceptable, implementing the proposed response at the organization (column 3 lines 12-16; column 24 lines 9-14).

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McFarland does not expressly disclose:

if the proposed response is not acceptable, performing a first negotiation between the organization and the auditing entity to determine a negotiated response;

if the negotiated response is not acceptable to both the organization and the auditing entity, escalating a status of the finding.

However, in an analogous environment, Ivanov teaches a method of document review where a preparer creates a document, a reviewer reviews the document and negotiation ensues until the document is declared “reviewed”, i.e. until both parties agree on the response. If an agreement is not reached, an escalation event occurs. (column 6 lines 6-9; column 7 lines 53-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Ivanov’s document review with McFarland’s audit. One of ordinary skill in the art would have been motivated to define efficient strategies for collective document evaluation.

As per claim 6, the above rejection of claim 5 is incorporated. McFarland further discloses:

determining if the implemented response is acceptable to the auditing entity (column 13 lines 23-26);

if the implemented response is acceptable to the auditing entity, setting a status of the finding to resolved (column 17 lines 48-52);

McFarland does not expressly disclose:

if the implemented response is not acceptable to the auditing entity, performing second negotiations between the organization and the auditing entity; and if the second negotiations do not result in a response acceptable to both the organization and the auditing entity, escalating a status of the finding.

However, in an analogous environment, Ivanov teaches a method of document review as cited in the above rejection of claim 5.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Ivanov's document review with McFarland's audit. One of ordinary skill in the art would have been motivated to repeat the defined efficient strategy for collective document evaluation after a first unsuccessful negotiation attempt.

As per claims 11-13 the rejection of claim 10 is incorporated. All further limitations have been addressed in the above rejections of claims 4-6.

As per claim 19, the rejection of claim 18 is incorporated. All further limitations have been addressed in the above rejections of claims 1, 4, and 5.

As per claim 20, the rejection of claim 19 is incorporated. McFarland discloses the use of email for sending reports to all related parties (column 15 lines 56-57). All further limitations have been addressed in the above rejections of claims 1 and 4.

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As per claim 21, the rejection of claim 19 is incorporated. All further limitations have been addressed in the above rejection of claim 6.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Derek Rutten whose telephone number is (571) 272-3703. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jdr



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